Supreme Court, U.S.
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No. 99-1066

IN THE SUPREME COURT OF THE UNITED STATES

JOHNNY BLASTOFF, INC.
Petitioner,
v.
LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INC., and NATIONAL FOOTBALL LEAGUE,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

REPLY TO BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

John C. Widule
Counsel of Record
Counsel of Petitioner
PO Box 108
Elm Grove, WI 53122
262-785-1752

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ARGUMENT

I.) THE SEVENTH CIRCUIT'S APPLICATION OF THE WRONG LEGAL STANDARD IN BLASTOFF WILL ENCOURAGE OTHER FEDERAL COURTS TO CONTINUE TO APPLY THE SAME INCORRECT LEGAL STANDARD

Respondents' Brief, at page 5, focuses in on a crucial aspect of the problem in Blastoff that the Supreme Court should address on certiorari:

> "The Seventh Circuit properly followed the well-accepted principle that [t]he determination of whether a party has established protectable rights in a trademark is made on a case by case basis, considering the **totality of the circumstances**. 'App. at A-10, citing New West, 595 F. 2d at 1200. In Lucent, the Third Circuit determined that the plaintiff, basing its claim of priority on a single sale of a product to an acquaintance of two officers of the company (see Lucent, 186 F. 3d at 317), failed to establish trademark rights superior to the intent to use applicant. In stark contrast, Respondents in this case amply **demonstrated** that prior to petitioner's application for registration, **use** of the mark ST. LOUIS RAMS was sufficiently widespread and public that a significant portion of the public identified the designation with the Rams Club. See App. at A-12."

The correct standard to be applied under Federal law for determining priority since the Trademark Law Revision Act of 1989 should be to require "use in the ordinary course of business," 15 USC 1051, 15 USC 1057, 15 USC 1127, not the more nebulous "totality of the circumstances." The Seventh Circuit in Blastoff ignored the requirement of "use in the ordinary course of business" and, instead, applied the "totality of the circumstances" standard. The record is clear and undisputed that there was no use in the ordinary course of business by any of the defendants. Frankly, defendants don't even make an "ordinary course of business" argument because they cannot on the record in this case. The "totality of the circumstances" standard applied from the New West case by the 9th Circuit in 1979 is entirely too unpredictable, and it was superseded by the use in the ordinary course of business requirement of the Trademark Law Revision Act (1989). In Blastoff, the Seventh Circuit regressed to pre-Act standards, thus perpetuating continued confusion and uncertainty which has lead to conflict and inconsistency between the circuits, and for which issue it is now necessary and ripe for Supreme Court correction in this case.

II.) CONFLICTING FACTS CUT AGAINST THE NFL DEFENDANTS, AND EVEN THEIR OWN RESPONSE BRIEF CONTAINS NO EVIDENCE OF ANY USE IN THE ORDINARY COURSE OF BUSINESS

Media speculation was also that the Los Angeles Rams would stay in Los Angeles, R-42, at #56, and, that *a fortiori*, if the NFL allowed a team to locate a franchise in St. Louis in the new St. Louis Stadium, it would be known as the "St. Louis Stallions". In fact, NFL Properties made authorized public representations that they had adopted and selected the name "St. Louis Stallions." The "NFL loved the name St. Louis Stallions" and wouldn't likely change it for the whims of any team owner. NFL Properties Vice President Rodger Goodell quoted in the St. Louis Post-Dispatch, Nov. 21, 1993. St. Louis Rams Partnership Vice President Bob Wallace's Deposition, Exh. #6, Widule Aff. at R-41, Exh. #47. When Blastoff's ITU's were filed, Blastoff was aware of the undisputed opposition of the NFL to a relocation of the Los Angeles Rams and of the reservation by the NFL with the U.S. Patent and Trademark Office of the name "St. Louis Stallions." The NFL was aware of Blastoff's filings at least as early as July 18, 1995, and should have been by March 10, 1995, and certainly by April 19, 1995. R-42, at #61.

This is the NFL we are talking about, boasting one of the premier trademark protection programs in the world, National Football League v. Wichita Falls Sportswear, Inc., 532 F. Supp 651, 656 (W.D. Wash.

1982). R-42, #20, p. 9. Now the NFL, at their Brief at page 2, rely for their rights upon

(i) a media report that a bar owner may have started a "St. Louis Rams" fan club (Did he really? Wasn't this just a press report too? Does it matter? Isn't it more important and significant that NFL Properties, exclusive licensor of all NFL trademarks and which had specifically prohibited any use of the name St. Louis Rams, <R-42 at #22(xiii), p. 16>, had a "St. Louis Stallions fan club" since 1993? <R-43, at #102>);

(ii) that season tickets were presold for "an NFL franchise" (not for "St. Louis Rams");

(iii) that the mayor of St. Louis is reported to have wanted the "St. Louis Rams" (or any other NFL team); and

(iv) that the St. Louis Post Dispatch indicated a desire for the name "St. Louis Rams" by printing the name on January 18, 1995. ("It is not official until the Commissioner and the owners sing", St. Louis Post-Dispatch,1/18/95; R-42, at #56, pg.24). Georgia Frontiere actually stated at the 1/17/95 unauthorized press conference: "I'm overwhelmed, I don't think I've been this happy since the last game we won" USA Today, 1/18/95, Heberer Aff. R-34, Exh. G. p. 1; R-42 at #11.

This is not use of the trademark at issue in the ordinary course of business. This is not adoption of a trademark by Respondents, or by anyone else.

III.) PETITIONER'S PETITION COMPLIES WITH SUPREME COURT RULES, AND IT IS THE NFL THAT DIDN'T FOLLOW THE RULES

Petitioner's petition for writ of certiorari is timely; was accepted as filed, and complies with all Supreme Court rules. Petitioner did not "evade" anything by timely seeking review and filing its Petition in the time period as ordered. Likewise, the merits of this case are that Johnny Blastoff, Inc. complied with all USPTO and Federal laws for trademark protection, but the NFL didn't. Don't let the person who complies with the rules, performs a search and files his ITU's with a bona fide intention to use be run over by large companies with no use and no filing.

IV.) RAMS IS GENERIC AS APPLIED TO THIS CASE

In Illinois High School Association v. Vantage, 99 F. 3d 244 (7th Cir. 1996), the Seventh Circuit noted that "for the sake of protecting effective communication it should be resolved against trademark protection, thus assimilating dual-use or multiple-use terms to generic terms." If the NFL wants to use the nickname "Rams", they should go right ahead, but that should not stop anyone else from using the nick-name Rams, including Blastoff. Id. The team name "St. Louis Rams" is a different story. That is not a generic term like the nickname "Rams". There is a recognized difference between team names and nicknames. National Football

League v. Wichita Falls Sportswear, Inc., 532 F. Supp 651, 656 (W.D. Wash. 1982) ("Seattle Seahawks" is the team name, while "Seahawks" is the nickname.) Blastoff's earlier ITU's, however, should carry the day for the name St. Louis Rams. 15 USC 1051, 15 USC 1057, 15 USC 1127. The "use" which the NFL wants this Court to reaffirm or find as having "demonstrated", is simply not use by defendants in the ordinary course of business as a matter of law. Lucent, 186 F. 2d 311 (3rd Cir. 1999), cert. denied on January 10, 2000; 15 USC 1057(c); 15 USC 1127.

V.) THE NFL'S OWN ROSTER CONFIRMS THE FALLACY OF THE NFL's ARGUMENTS

The NFL's "Tennessee Titans" team clearly demonstrates that, contrary to the NFL's assertions, an NFL team with a "city-based" geographical component ("Houston Oilers") may relocate and have a "state-based" geographical component (Tennessee rather than Nashville); and, that the team's nickname prior to relocation ("Oilers") doesn't mean it stays that way after relocation ("Titans").

VI.) THIS IS NO ROUTINE TRADEMARK CASE WHERE THE COURTS ACTED PROPERLY

This is no routine trademark case, it is a reverse confusion case, where not only did both lower courts apply the wrong legal standard, but have fostered continued uncertainty for businesses who utilize the

USPTO and federal law upon which to base their product naming and branding decisions.

VII.) PETITIONER ACCURATELY STATES THE RECORD; RESPONDENTS, HOWEVER, INAPPROPRIATELY LUMP TOGETHER "LOS ANGELES RAMS FOOTBALL COMPANY" WITH "ST. LOUIS RAMS PARTNERSHIP"

Petitioner accurately states the record. Respondents; at Brief page 1, however, assert the following definitions: "Los Angeles Rams Football Company, St. Louis Rams Partnership (together, the "Rams" or the "Rams Club") ---."

This implication of continuity is misleading and is indicative of much of the problem. There is no evidence of continuous use of the name St. Louis Rams by defendants until after April, 1995. R-42, #21. Los Angeles Rams Football Company changed its name to Rams Football, Inc. on April 14, 1995. R-43, #98, p. 3. St. Louis Rams Partnership includes owner Stan Kroenke, of Wal-Mart fame, R-42, at #121, operating as "ITB Football" since 2/8/95; R-43, at #98, pg. 3-4, and St. Louis Rams Partnership wasn't even formed until July of 1996. Id. At R-42, p. 1, Petitioner pointed out this objection to both lower courts:

"Response To Definitions: The definition of 'Rams' is vague and misleading, as 'Los Angeles Rams Football Company' and 'St. Louis Rams Partnership' are separate entities, with different owners, and the latter of which was not formed until after April 12, 1995, in fact,

on July 6, 1996." There was no actual continuity of use as required by Zazu Designs v. L'Oreal, S.A., 979 F2d 499, 503 (7th Cir. 1992). R-43 at #98, p.3.

Judge Posner recognized the obvious truth in Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership, 34 F. 3d 410, 412 (7th Cir. 1994) that an NFL team can only be in one place, at one time, with one name:

"Well, of course, they (Indianapolis Colts) were no longer playing football under the name 'Baltimore Colts', so could not have used the name as the teams trademark; they could have used it on merchandise but chose not to...." Id; R-42, at #91.

Likewise, the Respondents could have adopted or used the mark St. Louis Rams prior to 3/10/95, **but chose not to** (e.g. Press release by "L.A. Rams" on 2/8/95; R-43, at #21(b).). After discovering Blastoff's ITU filings, the NFL had the last clear chance to avoid this collision by not adopting or using the team name St. Louis Rams. Instead, they decided to out-muscle Blastoff just like they did to the existing wheelchair Baltimore Ravens basketball team in Baltimore. R-43, @ #54.

VIII.) BLASTOFF WAS UNABLE TO OVERCOME THE PUBLIC FEAR CREATED BY THE NFL'S TRADEMARK PROGRAM AND ITS USE OF THE NAME ST. LOUIS RAMS AFTER BLASTOFF'S ITU's WERE FILED

At its Brief, page 5, the NFL cites New West for the proposition that public perceptions are important to this

case. They are, but for a reason different than as proposed. Some background is in order:

Johnny Blastoff, Inc. worked in early 1994 with Reggie White to try to dovetail Blastoff's product development with Reggie's urban renewal and ministry efforts. R-43 @ #6. Blastoff wanted to encourage development of sports teams and clothing products for people in inner cities, both in imaginary cities (e.g., Reggieville Rappertiers, Reggieville Sluggers, Tower City Rams) as well as in real urban centers (St. Louis Rams, Phoenix Scorpions, Orlando Werewolves, Monterrey Cheetahs), Id. Blastoff promoted a Tower City Football League to play in imaginary as well as real cities (so the real city fans could better identify to the fictitious team), e.g., St. Louis was a real urban city that had a brand new vacant football stadium at the time (i.e. 1993-early 1995), Id, @ #7, #17-5. Tower City, home of the Johnny Blastoff cartoon character, See, e.g., http//www.johnnyblastoff.com., was conceived by Blastoff since 1993 as also being a futuristic version of the city of St. Louis. R-43, at #22-d, #65. Blastoff couldn't get shirts printed and distributed in May of 1995 by a major distributor due to the distributor's fear of the NFL even though Blastoff's president Rodney Rigsby had shown Blastoff's prior-filed ITU's to the distributor. R-43 at #93. Rigsby was arrested in Madison, Wisconsin in 1997 for trying to sell Blastoff's St. Louis Rams shirts at a U-2 concert in Madison. Id. This is a classic case of reverse confusion. Sands, Taylor and Wood Co. v Quaker Oats Co. 978 F. 2d 947, 957 (7th Cir. 1992).

It is also unfair competition, Id, 15 USC 1125, because the NFL's over-aggressive licensing and trademark

protection practices engender in the public the mistaken notion that trademark protection extends further than it does. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (3rd Ed.), Sec. 24.9; R-42 at #20, pg. 9. The NFL sent out cease and desist letters to Blastoff based upon registrations for "Rams" and "Los Angeles Rams", R-43 at #6, and so advised some of Blastoff's potential customers. Id. Public perception is important in this case, but not because it created non-existent rights for the NFL (because it didn't), but because the NFL's power and conduct prevents Blastoff from fair competition. Id. The NFL's standard business practice is to assert federal trademark registration status to the public, even when they don't have it. R-42 @ #19. That is not right. Neither is allowing the NFL to control all products in all product categories. Sands, Taylor and Wood Co. v. Quaker Oats Co. 978 F. 2d 947 (7th Cir. 1992).

IX.) CONCLUSION

Contrary to the Respondent's conclusion, the Petition for Writ of Certiorari should be granted.

John C. Widule
Attorney for Petitioner
Johnny Blastoff, Inc.
PO Box 108
Elm Grove, WI 53122
(262)785-1752